

Remarks

The specification was objected to because of informalities. Paragraphs [0012] and [0013] have been amended to overcome this objection.

Claims 13 to 20 were rejected under 35 U.S.C. 112, first paragraph. Claims 13 and 15 have been amended to overcome this rejection.

Claim 1 was rejected under 35 U.S.C. 102(e) as anticipated by Wainer. Claim 1 has been amended to better distinguish Applicant's invention over Wainer. Applicant's invention is for the storage and application of paint, which is a viscous, often brightly colored liquid. Paint from the touchup jar may be applied over marks on a wall or ceiling. If the paint drips onto the floor or carpet, it may be difficult to remove it. Wariner's invention is for the storage and application of mascara, which typically a thin, black liquid. It is applied over a sink or dresser, from which it may be easily removed if it drips.

Because the intended uses of the two inventions are so different, the devices themselves must be different. Since Applicant's invention is intended to be used to apply paint to cover marks on a wall or ceiling, her applicator must have a diameter sufficient to easily cover large marks in a few strokes, at least two inches in diameter. If the sponge is smaller than that, a great many strokes may be required to cover a small area of a wall or ceiling, the strokes will not be exactly even, and it will be obvious that the area has been patched. For that reason, all of Applicant's claims now require that the applicator, a sponge, must have a diameter of at least about two inches

(because the container and threaded rim are at least two inches in diameter and the diameter of the sponge must exceed the inside diameter of the threaded rim.)

Wainer, on the other hand, is not applying paint to a wall, but is applying mascara to eyelashes, which is delicate work and requires a small brush so that only the eyelashes receive the mascara. If the applicator was at least about two inches in diameter, a woman could easily end up applying the mascara not only to her eyelashes, but also to her nose, eyebrows, and cheeks. It is therefore undesirable and not obvious to make the thin brush used by Wainer into a sponge at least about two inches in diameter.

While Wainer does disclose (column 7, lines 49 to 56) that the applicator could be a foam sponge to apply other types of cosmetics to the face, these applications must also be done carefully and precisely and a two inch sponge would not be suitable for that work.

As the Examiner points out, Wainer does provide a “flexible finger 59” which can be pushed inward by button 21 to reduce the amount of mascara retained by applicator 97 (column 7, lines 16 to 24). This is very different from Applicant’s device as Wainer can alter the diameter of the constriction through which the applicator is withdrawn in order to control the amount of fluid retained on the applicator. Applicant’s device cannot be controlled in this manner to control the amount of paint on the sponge.

Applicant has amended Claim 1 to distinguish that difference between her invention and Wainer’s by using the words “consisting essentially of” instead of

“comprising.” That language excludes the addition of elements to Applicant’s touchup jar, such as Wainer’s variable diameter flexible finger, that alter the basic operation of Applicant’s invention. (Applicant has amended his Claims 13 and 15 by using the term “consisting of” instead of “comprising” to further limit her claims to exactly the structure that is described in the claims and to exclude “flexible fingers,” such as used by Wainer.)

In addition, Applicant has amended Claim 1 to require that the sides and the threaded rim of the container must be the same diameter and therefore both must be at least about two inches in diameter. This is necessary so that the sponge can slide down the inside wall of the container, wiping paint off the sides, as it is inserted into the container. That is not possible in Wainer’s device as his applicator never touches the sides of his container. It is not obvious to alter Wainer’s device so that his applicator touches the sides of his container because an important feature of Wainer’s device is to be able to alter the diameter of the flexible finger 59 to control the amount of mascara on the brush, and he could not do this if the brush was in contact with the sides of the container. Thus, in this manner Claim 1 further distinguishes over Wainer.

Finally, amended Claim 1 requires the sponge to have a diameter greater than the diameter of the threaded rim. (See paragraph [0009], line 5 and Figure 1 for support.) This is an important aspect of Applicant’s invention because the inside diameter of the rim is used to wipe excess paint off of the sponge so that paint does not drip onto the floor or carpet. If the diameter of the sponge did not exceed the inside

diameter of the rim, paint might drip off the sponge after it has been removed from the container. (See paragraph [0009], lines 5 and 6.) While Wainer's applicator does have a diameter greater than flexible finger 59, it does not have a diameter greater than threaded neck 35. For the reason given in the previous paragraph, it is not obvious to make the diameter of Wainer's applicator greater than the diameter of threaded neck 35. This is yet another way in which Applicant's Claim 1 distinguishes over Wainer.

Claims 2 and 4 to 14 were rejected under 35 U.S.C. 103(a) as unpatentable over Wainer. Wainer has been discussed hereinabove, and Applicant has nothing further to add to those comments.

Claims 1, 3, 7, and 9 were rejected under 35 U.S.C. 103(a) as unpatentable over Gelfand. Gelfand does not desire to apply a liquid to a surface using an applicator, as Applicant does, but rather seeks to evaporate a pleasant-smelling liquid from a wick in order to absorb bad-odors in the air. (Column 1, lines 1 to 8.) For that purpose, he requires a "wick," something that will, by capillary action, draw a liquid upward to the it's end, where it evaporates. Webster's Ninth New Collegiate Dictionary defines a "wick" as "a bundle of fibers or a loosely twisted, braided, or woven cord, tape, or tube usually of soft spun cotton threads that by capillary attraction draws up to be burned a steady supply of the oil in lamps or the melted tallow or wax in candles." In order to draw a liquid by capillary attraction, a wick must have capillaries, which are the elongated spaces between the fibers. Sponges consist of interconnected, somewhat-spherical voids, not elongated spaces, and therefore do not make good wicks. (Synthetic

sponges are made by forming gas bubbles in a polymer as it turns from a liquid into a solid.) For that reason, is not obvious to substitute a sponge for Gelfand's wick.

In addition, as pointed out hereinabove, all of Applicant's claims now require the sponge to have a greater diameter than the threaded rim so that the sponge contacts the sides of the container. Gelfand's wick does not have a greater diameter than his threaded neck and it would be undesirable for it to be made that way because Gelfand wants the excess liquid to collect in the inverted cap so it can be drawn up into the wick.

(Column 1, line 49 to column 2, line 3.)

Applicant's claims also require the threaded rim to have the same diameter as the vertical sides of the container, which is also not true of Gelfand. Nor would Gelfand want that to be true of his bottle as it would serve no useful purpose and would add to the cost of his bottle.

Applicant's use of the terms "consisting essentially of" in Claim 1 and "consisting of" in Claims 13 and 15 further distinguish over Gelfand because Gelfand requires "a stiffening means which keep [sic] the wick erect" (column 1, lines 35 to 36), which is wire 21 and 22. Such a wire cannot be used in Applicant's invention as it may scratch the surface being painted and leave marks on the paint.

For these reasons, Applicant's invention is not obvious over Gelfand.

Claims 15 to 20 were rejected under 35 U.S.C. 103(a) as unpatentable over Wainer in view of Gelfand. The Examiner argues that it would have been obvious to use to back-to-back lids in Wainer as shown by Gelfand. Applicant does not agree.

Wainer does not position his applicator in a vertical position. The applicator is either inside the container or it is in a woman's hand as it is being used. No one would let the applicator stand in a vertical position in the open air as the mascara could just dry on it and render the applicator useless.

And, as far as collecting liquid that runs back from the end of the applicator, Wainer already had a lid for collecting it, the inside of knob 89. Moreover, mascara is unlikely to run down from the end of the applicator in Wainer's invention because Wainer has specifically provided for flexible finger 59, the purpose of which is to remove excess mascara from the applicator. Thus, it is not obvious to use Gelfand's back-to-back lid in Wainer.

All of the claims are now believed to be allowable over the references cited, and reconsideration and allowance of all of the claims are therefore requested. Should the Examiner wish to discuss this application to resolve any remaining problems, he is invited to call Applicant's attorney at (716) 774-0091.

Respectfully,

Richard D. Fuerle  
Registration No. 24,640  
For Applicant

Richard D. Fuerle  
1711 West River Road  
Grand Island, NY 14072  
(716)-774-0091  
December 12, 2005  
CASE CL01